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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,884	10/05/2001	John R. Murphy	BOSTU 3.0-002 DIV	4828
530	7590	12/03/2003	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			WINKLER, ULRIKE	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/971,884	MURPHY ET AL.	
	Examiner	Art Unit	
	Ulrike Winkler	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20 and 23-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-20 and 23-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/2001. 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

An initialed and dated copy of Applicant's IDS form 1449, submitted October 5, 2001, is attached to the instant Office Action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-20, 23-43 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The claimed composition of matter is not supported by either a specific and substantial asserted utility or a well established utility because the specification states only that the composition of matter are useful for the screening of compounds that may be potential antibiotic or antibacterial substances in addition the composition of matter can be used to identify iron-independent repressors that have no disclosed specific and substantial asserted utility or a well established utility. The screening assay for potential antibiotic or antibacterial substances will take place at some future time only when the properties of the claimed composition might have been elucidated by the experimental methods disclosed in applicants specification. Absent a disclosure of those properties, the asserted utility of the method lacks specificity. Note, because the claimed invention is not supported by a specific and substantial asserted utility above, credibility has not been assessed.

Art Unit: 1648

Claims 18-20, 23-43 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-20, 23-25, 27-29, 35, 36, and 38-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification shows a method of screening substance that phenotypically convert a virulent or opportunistic prokaryote into a non-pathogenic organism. The specification discloses a positive selection method for identifying DtxR homologues and targets to identify iron independent repressors. The claims encompass a genus of compounds defined only by their function wherein the relationship between the structural features of members of the genus and said function (whether or not there is expression of the tetR, figure 3) have not been defined. In the absence of such a relationship either disclosed in the as filed application or which would have been recognized based upon information readily available to one skilled in the art, the skilled artisan would not know how to

make and use compounds that lack structural definition. The fact that one could have assayed a compound of interest using the disclosed assays does not overcome this defect since one would have no knowledge beforehand as to whether or not any given compound (DtXR homologue; a functional fragment of said operator; a variant of a DtxR consensus binding sequence) would fall within the scope of what is claimed. It would require undue experimentation (be an undue burden) to randomly screen undefined compounds for the claimed activity.

To comply with the written description requirement of 35 U.S.C. § 112, first paragraph, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was ready for patenting” such as by the use of drawings or structural chemical formulas that show that the invention was complete, or describing distinguishing identifying characteristics sufficient to show that the applicant was in Possession of the claimed invention.

Claimed invention is drawn to composition requiring identification by the method of positive selection of DTxR homologue. However, no structural or specific functional characteristics of such homologous are provided, nor is there any indication that the artisan actually implemented the disclosed method to identify any iron-independent repressors.

Claiming a product based on function does not provide sufficient description of the product. It has been well known that minor structural differences even among structurally related

compounds or compositions can result in substantially different biological or pharmacological activities. Therefore, structurally unrelated "molecules" encompassed by the claimed invention other than those disclosed in the specification as filed would be expected to have greater differences in their structural and functional characteristics and attributes. Mere idea or function is insufficient for written description; isolation and characterization at a minimum are required

"a mere wish or plan" for obtaining an invention is not enough to comply with § 112, ¶ 1 (*Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 559, at 1566).

The Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement make clear that if a claimed genus does not show actual reduction to practice for a representative number of species; then the Requirement may be alternatively met by reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 column 3).

The instant specification and claims do not provide sufficient functional and structural characteristics of the iron-independent repressors coupled with a known or disclosed correlation between function and structure. Since the disclosure fails to describe the common attributes or characteristics that identify members of the group, the disclosure of particular compounds is insufficient to describe the genus of molecules, encompassed by the claimed invention. Because one skilled in the art would conclude that the inventors were not in possession of the claimed invention. The claim fails to comply with the written description requirement.

Claims 18-20, 23-25, 27-29, 35, 36, and 38-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

To comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, the specification must enable one skilled in the art to make and use the claimed invention without undue experimentation. The claims are evaluated for enablement based on the Wands analysis. Many of the factors regarding undue experimentation have been summarized in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed.Circ.1988) as follows: (1) the nature of the invention, (2) the state of the prior art, (3) the predictability or lack thereof in the art, (4) the amount of direction or guidance present, (5) the presence or absence of working examples, (6) the quantity of experimentation necessary, (7) the relative skill of those in the art, and (8) the breadth of the claims. Such an analysis does not need to specifically enumerate (points 1-8) but only needs to have a select few of the factors present discussed in a rejection.

The specification shows a method of screening substance that phenotypically convert a virulent or opportunistic prokaryote into a non-pathogenic organism. The specification discloses a positive selection method for identifying DtxR homologues and targets to identify iron independent repressors. The claims encompass a genus of compounds defined only by their function wherein the relationship between the structural features of members of the genus and said function (whether or not there is expression of the tetR, figure 3) have not been defined. In the absence of such a relationship either disclosed in the as filed application or which would have been recognized based upon information readily available to one skilled in the art, the skilled

artisan would not know how to make and use compounds that lack structural definition. The fact that one could have assayed a compound of interest using the disclosed assays does not overcome this defect since one would have no knowledge beforehand as to whether or not any given compound (DtXR homologue; a functional fragment of said operator; a variant of a DtXR consensus binding sequence) would fall within the scope of what is claimed. It would require undue experimentation (be an undue burden) to randomly screen undefined compounds for the claimed activity.

The instant fact pattern fails to disclose any particular structure for the claimed DtXR homologue, a functional fragment of said operator or a variant of a DtXR consensus binding sequence. One cannot extrapolate the teachings of the specification to the scope of the claims because the claims are broadly drawn to any polypeptide fragment with sequence homology to DtXR homologue, a functional fragment of said operator or a variant of a DtXR consensus binding sequence, with or without the biological properties representative of what is claimed, and applicant has not enabled all of these types of modified nucleic acid structures because it has not been shown that these modified nucleic acids are capable of functioning as that which is being disclosed. The specification does not provide any guidance or any working examples in this unpredictable art, and thus the artisan would have been unable to have prepared the claimed composition without undue experimentation. Furthermore an assay for finding a product is not equivalent to a positive recitation of how to make such a product. This claim fails to meet the enablement requirement for the “how to make” prong of 35 U.S.C. § 112 first paragraph. In the absence of additional information the skilled artisan would not have been able to use the undisclosed compound(s) for treatment without undue experimentation.

Applicant is reminded that any amendment must point to a basis in the specification so as not to add new matter. See MPEP 714.02 and 2163.06.

Conclusion

Claims 26, 30-33 and 37 are objected to

Claims 18-20, 23-25, 27-29, 35, 36, and 38-43 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294, please note after February 2004 the telephone number will change to 571-272-0912. The examiner can normally be reached M-F, 8:30 am - 5 pm. The examiner can also be reached via email [ulrike.winkler@uspto.gov].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The official fax phone number for the organization where this application or proceeding is assigned is 703-872-9306; for informal communications please use 703-746-3162, please note after February 2004 the fax phone number will change to 571-273-0912

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


ULRIKE WINKLER, PH.D.
PATENT EXAMINER

12/1/03